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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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K&L Gates LLP			PANDYA, SUNT	
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CHICAGO, IL 60690			PAPER NUMBER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

### Office Action Summary

**Application No.**

10/659,093

**Applicant(s)**

GILLILAND ET AL.

**Examiner**

SUNIT PANDYA

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 24 and 37-98 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12, 24 & 37-98 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to amendments filed on 4/16/09, wherein the examiner acknowledges that claims 1, 37, 47-48, 55, 64, 73, 82, 88, and 89 have been amended, claims 94-98 have been newly added, and no claims have been canceled. Consequently, claims 1-12, 24 & 37-98 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-6, 9-11, 37, 39-42, 45-48, 50, 52-54, 58, 59, 61-63, 67, 68, 70-72, 76, 77, 79-81, 85, 86, 88, 92 and 94-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. (US 6,287,197 B1) in view of Tiberio (US 5,123,649).**

Regarding claims 1, 37, 47, 48, and 88, Dickinson discloses a gaming device comprising a display device, a primary game operable for one or more plays based upon one or more credits inserted by a player, a plurality of different game display interfaces (themes), available for a single one of the plays based upon a single one of the wagers in the primary game and operable to be displayed by the display device to

represent said primary game to the player, wherein each interface includes a plurality of different symbols, wherein the symbols in each interface are associated with an identical winning condition in the primary game with respect to corresponding symbols in another one of the interfaces, and wherein a plurality of the corresponding symbols in the interfaces are visually different from one another. Additionally, the device disclosed by Dickinson includes at least one input device (Operator Interface element 22), at least one processor (controller element 12) and at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the display device and the at least one input device (Fig. 1; col. 2, lines 49-67).

Specifically, Dickinson discloses a video game wherein a player may select a theme (col. 6, lines 5-6), each theme having a plurality of symbols that are visually different (Fig. 4) but are associated with an identical winning condition in the game (e.g. regardless of which theme is chosen the game is played in the same way, i.e. the symbols of the selected theme are to be matched to one another, if they are matched then a winning condition is obtained regardless of the theme chosen).

Dickinson does not specifically disclose the primary game operable for one or more plays based upon placement of a wager which corresponds to one of a first wager lever and a second wager level which is greater than the first wager level, nor does Dickinson specifically disclose the system receives an input associated with the placed wager, determines whether the placed wager corresponds to one of the first wager level and the second wager level, display the first game display interface if the placed wager

corresponds to the first wager level, display the second display interface if the placed wager corresponds to the second wager level, operate the single play of the game, determine an outcome of the play, and indicate the determined outcome. The primary embodiment of the invention disclosed by Dickinson is a video game wherein "the video game 10 may comprise virtually any type and/or size of video game including, for example, coin operated video games" (col. 2, lines 53-55) which may include slot machine-type casino games wherein a player places a wager in order to initiate said game. Additionally, while Dickinson does not specifically disclose the interface is chosen based upon a wager amount, Dickinson does disclose that the interface, i.e. theme, used in a play of the game may be chosen by multiple methods including randomly chosen by the game controller, based upon the level of the game, or by player selection (col. 6, lines 1-6).

In an analogous gaming device, Tiberio teaches a slot machine which includes a plurality of reels, wherein a player places a wager corresponding to a first wager level or a second wager level and an aspect of the primary game, is adjusted based upon said wager level (col. 2, lines 12-21). Additionally, Tiberio teaches the operating steps of a typical slot machine game including operating a play of the game based on the game machine operation, determining an outcome and indicating the determined outcome based on the wager (col. 1, lines 16-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of determining an aspect of game play based upon the wager level input by a player, as taught by Tiberio, with the disclosure of providing a plurality of different display interfaces (themes) having

visually different symbols that are associated with an identical winning condition in a game, as disclosed by Dickinson, as Dickinson discloses that the video game may be used in a coin-operated gaming machine and further because the interface, i.e. theme, may be chosen by a plurality of different methods. Thus, while not specifically disclosing that an interface, i.e. theme, is chosen by wager level, Dickinson provides a motivation for allowing for various methods of choosing a theme as well as motivation for providing the video game in a coin-operated slot machine device.

Regarding claims 3, 39, and 50, the combination of Dickinson and Tiberio teach that the primary game is a slot game including a plurality of the reels (Fig. 1).

Regarding claims 4, 40, and 51, Dickinson discloses the gaming device comprising at least two of the interfaces include at least one visually identical symbol in Fig. 4, wherein the gaming device features multiple "Popcorn" themes.

Regarding claims 5, 6, 41, and 42, Dickinson discloses each symbol is one of the interface has a corresponding symbol in another one of the interfaces, if the term "corresponding" is interpreted to mean "To be similar or equivalent in character, quantity, origin, structure, or function" (as defined by the American Heritage Dictionary, [www.Dictionary.reference.com](http://www.Dictionary.reference.com)). That is, Dickinson discloses interfaces the quantity of symbols in the "Blocks" theme corresponds to the quantity of symbols in the "Hands and Feet" theme (Fig. 4). In these two themes, the corresponding symbols are provided in a same frequency.

Regarding claims 9 and 45, Dickinson discloses a plurality of symbols of one of the interfaces correspond to symbols in another one of the interfaces, and wherein the

corresponding symbols have different but related indicia (Fig. 4, "Fast Food" and "Fruit" themes contain a plurality of symbols that are related as pertaining to edible objects).

Regarding claim 10, 46 Dickinson discloses a plurality of symbols of one of the interfaces correspond to symbols in another one of the interfaces, and wherein the corresponding symbols have different and unrelated indicia (Fig. 4, "Frogs" and "Mouths" themes contain a plurality of symbols that have different and unrelated indicia).

Regarding claim 11, each of the interfaces disclosed by Dickinson includes indicia consistent with a different game theme (Fig. 4).

Regarding claim 52-54, 61-63, 70-72, and 79-81, the combination of Dickinson and Tiberio teach a gaming device wherein the winning condition requires that a plurality of the symbols are displayed according to a designated spatial arrangement (i.e. on a win line 26 on slot machine reels 12,14 and 16; col. 3, lines 9-12). The spatial arrangement specifies a symbol combination which is satisfied by a plurality of symbols of a game display interface.

Regarding claim 58, 67, 76, and 85, Dickinson discloses the first display interface includes a first set of the symbols (Fig. 4, "Fish" theme contains 3 images) and the second game display interface includes a second set of the symbols, the second set of symbols including at least one symbol visually different from at least one symbol of the first set (e.g. the "Robots" theme would contain symbols that are visually different from the "Fish" theme).

Regarding claim 59, 68, 77, 86, and 92, Dickinson discloses the first game display interface is displayed for a first play of the game and the second game display interface is displayed for a second play of the game in that Dickinson discloses the display interface being changeable according to the level (col. 6, lines 4-5) such that a play at level 1 would utilize a interface different from that utilized during level 2 play.

Regarding claims 94-98, the combination of Dickinson and Tiberio teach data corresponding to different payout rate per wager (Tiberio col. 2, lines 12-21), a plurality of different game display interfaces, additionally, the device disclosed by Dickinson includes at least one input device (Operator Interface element 22, Dickinson), at least one processor (controller element 12, Dickinson) and at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the display device and the at least one input device (Fig. 1; col. 2, lines 49-67, Dickinson). However, the combination of Dickinson and Tiberio fails to teaches of a third game display interface which is different from the first two game display interfaces, and display the third interface if the placed wager corresponds to a third wager level. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement more than two display interfaces, corresponding to different wager levels, since it has been held that mere duplication of working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ8.

**Claims 2, 12, 24, 38, 49, 55-57, 64-66, 73-75, 82-84, 89-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson (US 6,287,197 B1), Tiberio (US 5,123,649) and further in view of Roffman et al. (US 6,375,568 B1).**

Regarding claims 2, 24, 38, 49, 55, 64, 73, 82, and 89, the combination of Dickinson and Tiberio fail to specifically disclose the first game display interface being associated with a first payable and the second game display interface being associated with a second payable which is different from the first payable, nor that at least two of the interfaces are characterized by having payouts with different volatilities, payouts yielded different expected values, payouts with different eligibility requirements, and payouts with different triggering mechanism.

However, in an analogous art, Roffman teaches each game theme, or interface, has a different pay table (col. 8, lines 60-61; Table IB and Table IIB), and further that the paytables have payouts yielding different expected values (as shown in Tables IB and IIB). It would have been obvious for one with ordinary skill in the at the time of the invention to combine the teaching of Dickinson and Tiberio to associate different game interfaces with a different payable, and further more, payouts yielding different expected values, as taught by Roffman, thus providing player with different awards associated with themes, resulting in more challenging wagering game which grasps and maintains player's attention(col. 21: 65-67).

Regarding claims 12, 56, 57, 65, 66, 74, 75, 83, 84, 90, 91 combination of Dickinson and Tiberio does not specifically teach each of the interfaces includes indicia consistent with a different game theme wherein each theme is selected from the group

consisting of: a movie theme, a television show theme, a music theme, a famous person/group theme, a sports theme, a famous historical event theme, and any combination thereof. However, Roffman discloses an analogous gaming device wherein a player may choose the theme of a slot machine game (col. 7, lines 1-18; col. 8, lines 10-18) from a general sports theme. That is, the interfaces a player may choose from include baseball, football, soccer, hockey, etc., which are of a sports theme (col. 7, lines 65-67). It would have been obvious for one with ordinary skill in the art at the time of the invention to combine the teaching of Dickinson and Tiberio to include indicia consisting of a movie theme, a television show theme, a music theme, a famous person/group theme, a sports theme, a famous historical event theme, and any combination thereof, as taught by Roffman, thus providing player with different awards associated with themes, resulting in more challenging wagering game which grasps and maintains player's attention(col. 21: 65-67).

**Claims 7, 8, 43, 44 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson (US 6,287,197 B1), Tiberio (US 5,123,649) and further in view of Nakagawa et al. (US 6,168,519 B1).**

Regarding claims 7, 8, and 43, the combination of Dickinson and Tiberio does not specifically teach each symbol in one of the interfaces has a corresponding symbol in each of the other interfaces, wherein corresponding symbols are provided in a same frequency in each of the interfaces. However, Nakagawa teaches a gaming device wherein a player may select an interface having a plurality of different symbols, each

visually different but functionally identical, for use in a game. Specifically, a player may choose a team “interface” for use in a soccer game, wherein each team has a plurality of players, i.e. symbols, that are functionally identical, i.e. all capable of the same actions during game play, but visually different, i.e. having different and distinguishing uniforms, etc. Every team contains the same number of players for use at corresponding positions (e.g. both team Japan and team Argentina will have 11 players on the field, one player at each position of defender, midfielder, forward, etc.), as shown in Fig. 3.

Essentially, allowing a player to choose an “interface” is nothing more than allowing a player to set personal preferences for game play. In the above recited references, a player is allowed to choose an interface containing symbols that appeal most to them, and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Dickinson and Nakagawa in order to provide a player with a more personalized video gaming experience.

Regarding claim 44, Dickinson discloses each symbol is one of the interface has a corresponding symbol in another one of the interfaces, if the term “corresponding” is interpreted to mean “To be similar or equivalent in character, quantity, origin, structure, or function” (as defined by the American Heritage Dictionary, [www.Dictionary.reference.com](http://www.Dictionary.reference.com)). That is, Dickinson discloses the quantity of symbols in the “Blocks” theme corresponds to the quantity of symbols in the “Hands and Feet” theme (Fig. 4). In these two themes, the corresponding symbols are provided in a same frequency.

**Claims 60, 69, 78, 87, 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson (US 6,287,197 B1), Tiberio (US 5,123,649) and further in view of Jaffe (US 6,443,837).**

Regarding claims 60, 69, 78, 87, and 93, the combination of Dickinson and Tiberio does not specifically teach a gaming device including a trigger event associated with the game, a bonus game operable after the trigger even occurs, and at least one processor operable to determine the trigger event, operate the bonus game and provide a bonus award as a result of a bonus award condition being satisfied. However, Jaffe teaches a gaming device including a trigger event associated with the game, a bonus game operation feature that is activated upon occurrence of the trigger event, and an award disbursement feature that provides a bonus award as a result of a bonus award condition being satisfied (col. 7, lines 33-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Dickinson and Tiberio with Jaffe, to provide players with a bonus or secondary game, thus offering players with a greater expectation of winning than the basic game, thus attracting players resulting in frequent play and hence increasing profitability.

### **Response to Arguments**

Applicant's arguments filed 4/16/09 have been fully considered but they are not persuasive.

In response to applicant's argument on page 25, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dickinson discloses that the video game may be used in a coin-operated gaming machine and further because the interface, i.e. theme, may be chosen by a plurality of different methods. Thus, while not specifically disclosing that an interface, i.e. theme, is chosen by wager level, Dickinson provides a motivation for allowing for various methods of choosing a theme as well as motivation for providing the video game in a coin-operated slot machine device. Further, video games are often incorporated into slot machine wagering type gaming devices, and Dickinson discloses the invention "may be implemented in virtually any video game which is to display multiple images" (col. 5, lines 39-42).

In response to applicant's arguments against the references individually on page 14, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the rejection is formulated based on the combination of Dickinson and Tiberio, wherein the combination of the said references essentially

disclose all of the limitations claimed in the independent claims (see updated rejection above for details rejection).

Regarding the applicant's arguments on page 26 that Tiberio's payout rate varies with the wager amount, the first and the second payout rates are not the same, and Dickinson and Roffman do not correct such deficiency, the examiner respectfully disagrees. As recited in the rejection above, Dickinson discloses a video game wherein a player may select a theme (col. 6, lines 5-6), each theme having a plurality of symbols that are visually different (Fig. 4) but are associated with an identical winning condition in the game (e.g. regardless of which theme is chosen the game is played in the same way, i.e. the symbols of the selected theme are to be matched to one another, if they are matched then a winning condition is obtained regardless of the theme chosen).

Regarding applicant's arguments related to the newly amended features in the claims. The examiner would like to respectfully direct the applicant's attention to the rejection above, wherein the rejection has been updated to reflect the amendments made to the claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUNIT PANDYA whose telephone number is (571)272-2823. The examiner can normally be reached on M-Th 8 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES S. MCCLELLAN/  
Primary Examiner, Art Unit 3714  
SP

